UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/764,369	01/26/2004	Randall White		8101

7590 01/30/2007

Theresa M. Seal
C/O The Inverntor's Network, Inc
332 Academy Street
Carnegie, PA 15106

EXAMINER	
CHAWLA, JYOTI	
ART UNIT	**PAPER NUMBER**
1761	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/764,369	WHITE, RANDALL	
	Examiner	Art Unit	
	Jyoti Chawla	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *October 10, 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *3 and 4* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *3 and 4* is/are rejected.

7)☒ Claim(s) 3 and 4 is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Specification

The amendment filed October 10,2006 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "While the above ingredients can be mixed in various quantities and proportions, one suggested admixture of the ingredients is as follows: three pounds of beef, four ounces of soy sauce, five ounces of teriyaki sauce, one and 3 quarter ounces of Worcestershire sauce, six ounces of mesquite liquid smoke, and 20 shakes of the seasoned salt. This admixture of ingredients will produce a food product that is neither hot nor sweet, but will create a food product that will maintain its flavor until the individual has completed chewing the last bite."
Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

Claims 3 and 4 are objected to because of the following informalities: The term "season salt" as recited seems to be a typographical error. Since *seasoned salt* has been a known food additive, therefore, the term season salt should be replaced with "seasoned salt". Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 3 and 4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 3 recites "A method of producing beef jerky having a unique and distinctive aroma and flavor, which comprises the steps of: slicing three pounds of beef product into thin strips; marinating the beef strips *for at least two hours* in four ounces of soy sauce, five ounces of teriyaki sauce, six ounces of mesquite liquid smoke, one and ¾ ounces of Worcestershire sauce, and 20 shakes of a season salt; dehydrating the marinated beef strips until they become crisp; and packaging the beef strips into containers."

Claim 4 recites "Beef jerky strips having a unique and distinctive aroma and taste, comprising: three pounds of beef that are sliced into a plurality of thin beef strips; the beef strips intermixed and soaked for at least two hours in four ounces of soy sauce, five ounces of teriyaki sauce, one and ¾ quarter ounces of Worcestershire sauce, six ounces of liquid smoke and at least 20 shakes of season salt; and the beef strips dehydrated until they are crisp and capable of being broken into pieces by an individual's hands and fingers and whereupon each beef strip maintains its flavor until the individual consumes the last bite of the beef strip."

Claims 3 and 4 both contain subject matter that has not been described in the original disclosure in such a manner as to enable one of skill in the art that the inventors had possession of the claimed invention.

The original disclosure for the instant application (Summary of the invention page 3) states "The present invention comprehends a recipe and processing steps for producing a new type of beef jerky. In order to produce the beef jerky of the present invention, the meat product is sliced thin and then marinated for up to two hours. When the meat product turns brown it is placed in a dehydrator until it becomes crisp. The ingredients with which the meat product is marinated include soy sauce, teriyaki sauce, Worcestershire sauce, mesquite liquid smoke, and salt. It is an objective of the present invention to produce a new type of beef jerky that has a unique flavor not currently

available on the market. It is another objective of the present invention to produce a new type of beef jerky that can be broken by one's fingers into bite size pieces. It is yet another objective of the present invention to produce a new type of beef jerky that is very thinly sliced so that pieces of the jerky can be easily broken off by one's fingers. These and other objects, features, and advantages will become apparent to one skilled in the art upon a perusal of the following detailed description read in conjunction with the following drawing figures."

Furthermore, the detailed description of the invention (pages 4 and 5 of the original disclosure) states "The following steps are necessary for producing the new type of beef jerky of the present invention. First, the meat product - the beef parts- must be thinly sliced. Then the thinly sliced beef strips must be marinated for *up to two hours* with the following ingredients: soy sauce, teriyaki sauce, mesquite liquid smoke, Worcestershire sauce, and salt. When the beef strips turn brown the beef strips can then be put in a dehydrator until they turn crisp. The beef strips can then be packaged as a new type of beef jerky having a unique and distinctive aroma and taste." The original disclosure also states (Detailed description Page 5). "Numerous modifications, alterations, and variations of the present invention are possible and practicable, and will become apparent to those skilled in the art, and, accordingly such modifications, alterations, and variations will fall within the scope of the present invention and the appended claims."

For example, the new claims 3 and 4 state that the beef strips are "marinated for at least two hours", whereas the original disclosure states that the beef can be marinated for "up to two hours". It is noted that "up to two hours" would be considered to mean 1-120 minutes, whereas "for at least two hours" would be considered to mean 120 minutes or more. Furthermore, the original disclosure does not provide specifics, such as, 3 pounds of beef, 4 oz soy sauce, 5 oz of teriyaki sauce etc., in making of the Beef jerky claimed in the instant invention. Thus the applicant does not have support for the newly added claims 3 and 4 in the disclosure as originally filed in the instant application.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3 and 4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "crispy" in claims 3 and 4 is a relative term, which renders the claims indefinite. The term "crispy" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to what constitutes "crispy", as instantly claimed. Whether the beef strips are brittle and crumbly or burnt and crisp. In order to expedite prosecution the term "crisp" would be regarded as dry and for beef jerky product "crisp" would be regarded as a product that can be broken off into a piece with ease.

The term "20 shakes of a season salt" is a relative tem, which renders the claim indefinite. The term "20 shakes" has not been defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. It is unclear as to what constitutes "shakes", as instantly claimed. Furthermore, it is also unclear what is the size of the "orifice(s) or holes, of the shaker". Both the above-mentioned criteria would affect the amount of seasoned salt that is instantly claimed to be added in "20 shakes" as recited in claims 3 and 4. Clarification and/ or correction is required.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Beef Jerky Recipe" hereinafter "Jerky" posted on www.microwebtech.com, posted December 12, 1998 (Date verified by www.archive.org), in view of recipe for "Beef Venison Jerky" hereinafter "Venison" posted on www.recipelink.com on January 1, 1999.

The references and rejection are incorporated herein and as cited in the office action mailed May 17, 2006.

Regarding Claims 3 and 4, "Jerky" teaches method of producing beef jerky by slicing the beef product into thin strips (recipe body, page 1); marinating the beef strips for up to 24 hours (i.e., at least 2 hours as recited in the claims) (recipe body, page 1) with soy sauce, teriyaki sauce, liquid smoke any flavor (i.e., Mesquite liquid smoke), Worcestershire sauce (ingredient list). The reference also teaches dehydrating the beef strips (recipe body, page 2) until one can break off a piece with ease (recipe body, page 2) and packaging the beef strips into sealed containers or zip lock bags (recipe body, page 2).

Regarding degree of dryness recited in claims 3 and 4 "Jerky" teaches that the jerky should be dry and done when it no longer bends and can be broken off into a piece with ease (recipe body, page 2). The reference does not teach the term "crisp" as a desirable characteristic the tem "crisp" (relative term) is interpreted as meat that has been overly dry. However, the reference clearly teaches that the beef jerky should be dry and done when it no longer bends and can be broken off into a piece with ease, which is also the intent of the applicant. Since "crisp" is a relative term, it may mean easily breakable (applicant) to one individual and overly dehydrated or crumbling on its own ("Jerky") to another. Therefore, after taking into account the relative nature of the term "crisp" and then considering applicant's recitation as a whole, i.e., "crisp and

capable of being broken into pieces by an individual's hands and fingers", "Jerky" reference teaches the same characteristic in its product as instantly claimed.

Regarding claims 3 and 4, "Jerky" teaches a plurality of thinly sliced beef strips as it teaches thinly sliced trimmed 5lb piece of beef brisket (ingredient list) the beef strips intermixed and soaked in soy sauce, teriyaki sauce, Worcestershire sauce, mesquite liquid smoke (ingredient list), and the beef strips dehydrated until they are and capable of being broken into pieces by an individual's hands and fingers (recipe body, page 2). The newly added claims (new matter) further call for amounts/ratios of ingredients used in the marinade. The "Jerky" recipe does not teach the specific amounts of meat and sauces and other marinade ingredients in the same amounts as recited by the applicant, however, the reference teaches all the essential steps of the method of making the beef jerky as instantly claimed. Using flavors and sauces in an amount different from the one taught by "Jerky" recipe would have been obvious to one of ordinary skill in the art at the time of the invention. Such determination would have been well within the purview of a skilled artisan, and it would have been further obvious to arrive at such amounts/ratios as a matter of preference depending on, for example, the particular flavor/ color/ texture/ nutritional makeup desired in the final beef jerky product.

The applicant is also reminded that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). "When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not." In re Spada, 911F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990). Furthermore, applicant is referred that a recitation of the method of making the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Thus, the claimed invention would have been obvious, absent any clear and convincing evidence and/or arguments to the contrary.

Regarding the addition of salt in claims 3 and 4 "Jerky" does not teach addition of salt per se, however, salt is present as part of the sauces taught by "Jerky" to make the marinade. However, "Venison" recipe teaches salt to taste in its ingredient list. Therefore, it would have been obvious to one with ordinary skill in the art to modify "Jerky" and add salt to taste as salt has been a well known pickling, dehydrating and preserving agent and has been employed in the art for making jerky as taught by "Venison". Ingredients, such as, salt are well known in the art. The addition of same is not seen as a patentable distinction but merely an ingredient incorporated for it's own art recognized contribution of taste, for example, degree of saltiness desired in the final product based on the amount of salt in the other ingredients in the marinade. It would have been obvious to one having ordinary skill in the art at the time of the invention to have incorporated such ingredients as a matter of preference depending on, for example, availability, taste, or nutritional attribute desired.

Further, attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in fact situation of the instant case. At page 234, the Court stated as follows: This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients, which produces a new, unexpected and useful function. In re Benjamin D. White, 17 C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

Regarding the instantly-claimed Beef Jerky composition, there appears to be no unexpected cooperative relationship or properties resulting from the use of such commonly-used ingredient as salt, which would be selected by one of ordinary skill in the art to contribute its known properties and flavor characteristics to the claimed composition.

Therefore, claims 3 and 4 (new matter) are obvious over "Jerky" in view of "venison" references.

Response to Arguments

Applicant's arguments filed October 10, 2006, with respect to claims 3 and 4 have been fully considered but are moot in view of the new ground(s) of rejection. Applicant is referred to the office action above in response to the arguments.

Regarding the argument that the In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "new claims 3 and 4 also recite specific amounts or proportions for each ingredient whose admixture produces the unique properties of crispness and maintaining of the flavor until the individual has completed chewing the last bite of the beef jerky strip.") (Remarks, page1) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant's arguments regarding claims 1 and 2 have not been considered, as the claims have been cancelled.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jyoti Chawla whose telephone number is (571) 272-8212. The examiner can normally be reached on 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on (571) 272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Jyoti Chawla
Examiner
Art Unit 1761

MILTON I. CANO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700